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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,849	04/12/2004	Russell A. Firestone III	36707-502	1735
64046 7590 04/27/2009 MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C. ONE FINANCIAL CENTER BOSTON, MA 02111				
EXAMINER BROOKS, MATTHEW L.				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/821,849

**Applicant(s)**

FIRESTONE, RUSSELL A.

**Examiner**

MATTHEW L. BROOKS

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This communication is in response to the original filing on 23 December 2008.

### ***Status of Claims***

2. Original claims 1-24 are currently pending. Claim 25 has been cancelled.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 2-4 and 15-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.
5. With respect to **claim 1**, the "monitoring the return of the first container from the waste treatment facility to the waste generating facility with the wireless tracking device" is not disclosed in the specification.
6. With respect to **claim 15**, there is no teaching of how to calculate an amount representative of what is owed based on a type of the medical waste and a weight of the medical waste. That is to say it would require undue experimentation to figure out what type of waste cost what to recycle.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Patent Number: 5,347,274 (Hassett).

9. With respect to **claim 1** : Hassett teaches a method of tracking medical or toxic waste comprising: monitoring the movement of a first container having a wireless tracking device attached thereto from a waste generating facility to a waste treatment facility using the wireless tracking device (Hassett teaches wireless tracking device attached to waste container at Fig 3A, '8 AND C1, 55-60 "method of electronically marking, identifying and managing hazardous cargo...")

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 2-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Hospitals Use Alternative Off-Site Methods"; Barlow, Rick Dana. Hospital Material Management. Ann Arbor: Aug 1992. Vol 17, Iss. 8; pg. 14, 4 pgs) (herein after Stericycle), and in further view of Patent Number 7,035,856 B1 (Morimoto) and further in view of Hassett as applied to claim 1 above.

Stericycle teaches that recycling/medical waste treatment companies where distributing/shipping OR "returning to" a waste generating facility a specialized containers to hospitals ("Steritubs, which are then distributed to hospital clients..." (bottom of p. 2) and that the hospital "receives plastic containers as part of the contract" (p.2, second full paragraph).

It fails to teach how these special containers were distributed to the hospitals.

Morimoto teaches an "efficient" system for tracking and routing a specialized container/s to be distributed (C2, 7-10). Specifically it teaches a first container, the container having a wireless tracking device attached thereto (Fig. 1A, 40A); and

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a tracking station capable of monitoring the movement of the container by tracking the wireless tracking device (Fig 2 and 3).

And monitoring the movement of a first container having a wireless tracking device attached thereto from one point to another second point using the wireless tracking device (C1, 5-12). And all other features normally provided by a tracking system such as hand held reader (C3, 10); satellite or cellular station (Fig 3); use of a computer (Fig 2, 90); weighing capabilities (C2, 65-67); and wherein the wireless tracking operates at radio frequencies (C3, 2)

It would be obvious to one of ordinary skill in the art to include in the distributing of steritubs/containers as taught by Stericycle the ability to place a rewritable RF chip on the shipped container to the final destination as taught by Morimoto since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Stericycle and Morimoto fail to teach how the containers once at a destination, when filled with medical waste would be sent back to a waste treatment center.

However Stericycle teaches that hospitals at the time where starting to ship there waste off site to be disposed (p. 1; line 1) and that the hospital chose Stericycle because of its recycled containers (p. 1 end of abstract) and Hassett teaches monitoring the waste container from where waste is generated to point

of disposal, further it teaches placement of tracking tags on waste containers to keep track of them (see claim 1 above).

It would have been obvious to one of ordinary skill to one in possession of both Stericycle and Morimoto, to utilize the rewritable RF chip already placed on the container as shown in Morimoto, to ship back the waste with the RF chip on a container as shown in Hassett above, since the invention is merely a combination of old elements, and each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results were predictable.

13. With respect to **claims 3 and 16**: the combination teaches, wherein monitoring comprises scanning the wireless tracking device with a handheld reader (Hassett, Fig 3A, 4a).

14. With respect to **claim 4** : the combination teaches, further comprising uploading tracking data to a monitoring station (Hassett, Fig 1, 8 to 4).

15. With respect to **claim 5** : the combination teaches, wherein the medical waste is segregated according to type prior to putting it in the medical waste container (Stericycle; p. 3, 4<sup>th</sup> paragraph, separate at front end).

16. With respect to **claim 6 and 19**: the combination teaches, further comprising weighing the first container with waste prior to treating the waste (Hassett C6, 1-10; sense changes in weight of load AND Stericycle; p. 2, subtracts weight of containers) .

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17. With respect to **claim 7** : the combination teaches, further comprising determining the amount of waste in the container (Hassett C6, 1-10; sense changes in weight of load AND Stericycle; p. 2, subtracts weight of containers).

18. With respect to **claim 8** : the combination teaches, further comprising calculating how much to charge a customer based on the type of waste and the weight of the waste (Stericycle; p. 2; 2nd paragraph "infectious waste").

19. With respect to **claims 9 and 10**: the combination teaches, further comprising billing the customer based on type and weight (Stericycle; p. 2, 2<sup>nd</sup> paragraph; the automation of such and including an invoice would have been obvious to one of ordinary skill).

20. With respect to **claim 11 and 21** : the combination teaches, further comprising supplying a second container, the second container adapted to hold treated medical waste (Stericycle; p. 2, bottom of page "steritubs").\

21. With respect to **claim 12**: the combination teaches, further comprising tracking the second container to a landfill or recycling center (Stericycle is a recycling center).

22. With respect to **claims 13 and 20**: the combination teaches, further comprising supplying the customer with an invoice, the invoice including confirmation of the delivery of the waste to the landfill or recycling center (Stericycle; p. 2, 2<sup>nd</sup> paragraph; the automation of such and including an invoice would have been obvious to one of ordinary skill AND Hassett, C1, 65-bottom; "confirm delivery after a shipment has been received AND C2, 1-10 "verify receipt or delivery of load at an end point..." AND Hassett teaches generation of

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reports C2, 5-10 and to include a "manifest" of confirmation of destruction was known and thus obvious to one of ordinary skill at time of invention).

23. With respect to **claims 14 and 22** : the combination teaches, wherein the wireless tracking device operates at radio frequencies (Hassett; C2, 35-40 AND Claim 7).

24. With respect to **claim 15** : the combination teaches a system for tracking medical or toxic waste comprising (Hassett; C2, 12-20): a first container adapted to hold untreated medical waste, the first container having a wireless tracking device attached thereto (Hassett teaches wireless tracking device attached to waste container at Fig 3A, '8 AND C1, 55-60 "method of electronically marking, identifying and managing hazardous cargo...");

and a tracking station capable of monitoring the movement of the medical waste by tracking the wireless tracking device (Fig 1, 2 "central data processor" and, when the waste is destroyed, calculating an amount representative of what is owed based on a type of the medical waste and a weight of the medical waste (Stericycle; p. 2; 2nd paragraph "infectious waste" and p. 3 \$90,000 per year),

25. With respect to **claims 17** : the combination teaches, further comprising a satellite or cellular station (Hassett; C5, 25-32).

26. With respect to **claims 18** : the combination teaches, further comprising a computer to track said container (Hassett, C3, 46-48 "central computer").

27. With respect to **claims 23** : the combination teaches, wherein the segregated waste comprises sharps containers (Stericycle; p. 2 bottom of page, "syringes").

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28. With respect to **claims 24** : the combination teaches, further comprising processing the sharps containers (Stericycle; p. 3, separate at front end) and sending the processed sharps containers to a recycling facility (same, "so Stericycle can recycle...").

### ***Response to Arguments***

29. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Patent No.: US 6,321,983 B1 (Katayanagi) – which discloses monitoring a container throughout its lifecycle.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW L. BROOKS whose telephone number is (571)272-8112. The examiner can normally be reached on Monday - Friday; 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John G. Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew L. Brooks/  
Patent Examiner, Art Unit 3629  
4/22/2009